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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,735	06/25/1999	HERMAN BERG	GENE1110-1	9401

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EXAMINER

SERKE, CATHERINE

ART UNIT PAPER NUMBER

3763

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/344,735

Applicant(s)

BERG ET AL.

Examiner

Catherine Serke

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13-19, 23-45, 52-54, 56-58 and 62-68 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-18, 23, 24, 32-39, 41-45, 52-54, 56, 57, 62 and 63 is/are rejected.
- 7) ☒ Claim(s) 25-31, 40 and 64-68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of the species of Group II in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the restriction requirement is unclear. This is not found persuasive because the examiner did not make a restriction requirement in paper number 7 but instead required an election of species. An election of species is proper when the specification and claims are drawn to multiple embodiments of an invention that are patentably distinct. Additionally, the burden of identifying the claims that are drawn to the elected species falls on the applicant. The requirement is still deemed proper and is therefore made FINAL.

The examiner notes that a call was placed to applicant's representative regarding the elected claims and the claims were discussed with June Learn on 4/17/02. The examiner was unclear as to the elected claims since some of the non-elected claims seemed in the opinion of the examiner to read on the elected species and some of the elected claims did not, specifically claims 19 and 58. The examiner and Ms. Learn discussed the invention regarding structure and function and the examiner noted that claims 19 and 58 did not read on the elected invention, specifically method and apparatus for internal application. Therefore claims 19 and 58 have not been included in the elected claims below.

Claims 19 and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 recites a temperature range but does not provide the measurement unit. Appropriate correction is required in order to understand the scope of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 13-18, 32-33, 36-37, 52-54 and 56-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Haselton, III et al (US 6,242,258).

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Haselton ('258) discloses a method for treating that includes administering a photosensitive agent (caging group, see 4:25-35) to a subject for inhibiting cell growth or enhancing cell death or for treating a cell proliferative disorder (antisense application for encoding a product that promotes cell killing, see 3:40), applying an electric pulse (electroporation, see 7:23) to a cell of the subject of a sufficient strength and duration to electroporate the cell with the photosensitive agent (see 7:18-22), and applying light (see 5:17-20) of an activatable wavelength (see 11-13) to the cell thereby activating the agent and treating the cell.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 23-24, 34-35, 38-39, 41-45 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haselton in view of Zewert et al (US 5,749,847).

Haselton meets the claim limitations as described above but fails to disclose applying multiple pulses to the cell, applying heat to the cell, and treating cancer. Zewert ('847) discloses delivery of a nucleotide agent by electroporation that includes delivering antisense nucleotides for treatment of cancer. The device utilizes electrodes for increasing the permeability of cell membranes. The electrodes administer a series of electric pulses (see 3:20-35). It is considered

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inherent that the administration of the electric pulses to the cell will generate heat to about 36-42 degrees. The delivered agent can further include a radioactive label.

Allowable Subject Matter


Claims 25-31, 40 and 64-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine Serke 
April 22, 2002


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700